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PATENT
Customer No. 22,852
Attorney Docket No.: 3626.0034-09

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
)
Ernest LAWTON, et al.) Group Art Unit: 1774
)
Application No.: 09/705,575) Examiner: J. Gray
)
Filed: November 3, 2000)
)
For: IMPREGNATED GLASS FIBER)
STRANDS AND PRODUCTS)
INCLUDING THE SAME)

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Assistant Commissioner for Patents
Washington, DC 20231

Sir:

RESPONSE UNDER 37 C.F.R. § 1.111

In reply to the Office Action dated February 13, 2003, Applicants respectfully request reconsideration of the subject application in light of the following remarks.

REMARKS

I. Status of the Claims

Claims 1-3 and 6-37 are pending in this application. Claims 12-17, 26-32, and 35-37 remain withdrawn from consideration as being directed to non elected species of invention.

Applicants acknowledge the Examiner's withdrawal of the previous indication that claim 5 as originally filed was directed to allowable subject matter. It is Applicants understanding that this indication of allowable subject matter was withdrawn due to the discovery of new prior art. For the reasons set forth below, however, Applicants

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respectfully submit that this new prior art fails to anticipate or render obvious the invention recited in the pending claims.

II. Rejections under 35 U.S.C. § 102

The Examiner rejected claims 1-2, 18-21, 24, 25, 32, and 33 under 35 U.S.C. § 102(b) as being anticipated by U.S. Pat. No. 5,024,890, 5,312,687, and 5,387,468 to Pollet ("Pollet"). The Examiner alleges, *inter alia*, that Pollet teaches "the powdered coating can contain organic or inorganic particulates that can be either pre-combined with the polymer so that each powder particles [sic] contains polymer and filler, or be added separately as a powder." Office Action at 3. The Examiner further alleges that "[I]t should be noted that the language of particles embraces thermoplastic resin powder." *Id.* Applicants respectfully disagree.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *M.P.E.P.* § 2131. For at least the reasons that follow, Applicants respectfully submit Pollet fails to anticipate the claimed invention.

Independent claim 1 recites that the claimed plurality of particles are "selected from inorganic particles, organic hollow particles, composite particles, and mixtures of any of the foregoing." See claim 1. Independent claim 32 recites that the claimed plurality of particles are "selected from inorganic particles, organic hollow particles, and composite particles." See claim 32. As stated in the specification, the term "composite" as used in independent claims 1 and 32 is defined as a "combination of two or more

differing materials. The particles formed from composite materials generally have a hardness at their surface that is different from the hardness of the internal portions of the particle beneath its surface." Specification at 15, lines 18-20.

Pollet discloses glass fibers impregnated with thermoplastic or polyester resin powders; this limited disclosure, however, does not teach the use of composite particles, as defined in the present application, organic hollow particles, or inorganic particles. While Pollet does disclose certain resin powders, nothing in Pollet discloses the use of 1) any organic hollow particles or 2) any composite particles as expressly defined in the instant application. Applicants therefore respectfully disagree with the Examiner's conclusion, and submit that the language of independent claims 1 and 32 does not necessarily embrace thermoplastic resin powder.

Additionally, nothing in Pollet describes any inorganic particles having a Mohs' hardness that does not exceed the Mohs' hardness of the glass fiber. Pollet therefore fails to disclose the presently claimed plurality of particles, and each and every element of independent claims 1 and 32 is therefore not expressly or inherently described by Pollet. Accordingly, Applicants respectfully request the Examiner to withdraw this rejection.

III. Rejection Under 35 U.S.C. § 103

The Examiner rejected claims 3, 6-11, 22, 23, and 32-34 under 35 U.S.C. § 103(a) as being unpatentable over Pollet as applied to claims 1-2, 18-21, 24-25 and 32-33, in view of U.S. Pat. No. 5,460,883 to Barber and U.S. Pat. No. 6,270,562 B1 to

Jia. The Examiner alleges that Pollet "is silent as to the use of the specific inorganic particles and glass fibers." Office Action at 4. The Examiner claims that this deficiency is cured by Barber, which "teaches filaments comprising a core at least partially coated with a coating composition comprising greater than 20 weight percent particles." *Id.* The Examiner then concludes "[I]t would have been obvious to use as the inorganic particles taught by Pollet any inorganic particulate material known in the art, such as any of those taught by Barber." *Id.*

To establish a prima facie case of obviousness, the Examiner must meet three basic criteria, as set forth in M.P.E.P § 2143. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. See M.P.E.P. § 2143. Furthermore, the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in Applicants' disclosure. See *In re Vaeck*, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

The Federal Circuit has held that there must be a clear and particular suggestion in the prior art to combine the teachings of the cited references in the manner proposed by the Examiner. As explained by the Federal Circuit, "[o]ur case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based

obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references.” *In re Dembiczak* 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).

The Examiner can meet the burden of establishing a *prima facie* case of obviousness “only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references.” *In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988) (internal citations omitted) (emphasis added).

The Federal Circuit again reaffirmed the Examiner’s high burden to establish a *prima facie* case of obviousness in *In re Sang-Su Lee*, and emphasized the requirement for specificity. In *In re Sang-Su Lee*, the Federal Circuit held that “[t]he factual inquiry whether to combine references must be thorough and searching. It must be based on objective evidence of record. This precedent has been reinforced in myriad decisions, and cannot be dispensed with.” *In re Sang-Su Lee*, 61 U.S.P.Q.2d 1430,1433 (Fed. Cir. 2002). Further, the Federal Circuit explained that

[t]he need for specificity pervades this authority... the examiner can satisfy the burden of showing obviousness of the combination only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references.

In re Sang-Su Lee at 1433-1434 (internal citations and quotation omitted) (emphasis added).

With respect to claims 1 and 32, Applicants respectfully submit that the requisite objective teaching is not present in Pollet, Barber or Jia. Specifically, the combination of references is lacking any specific, objective teaching regarding the use of a plurality of particles as defined in independent claims 1 and 32, which were rejected by the Examiner under § 103(a). Each of these independent claims recites that the “plurality of particles have a Mohs’ hardness value which does not exceed the Mohs’ hardness value of the glass fiber. Independent claim 1 further recites, in relevant part, that the plurality of particles are chosen from inorganic particles, organic hollow particles, composite particles, and mixtures of any of the foregoing,” and independent claim 32 further recites, in relevant part, that the plurality of particles are chosen from “inorganic particles, organic hollow particles, and composite particles.”

The rejection set forth by the Examiner points to no specific, objective teaching in any of the prior art references relied upon in the rejection that would have led to the Examiner’s conclusion that “any inorganic particulate material known in the art” could have been used in the teachings of Pollet. In fact, Applicants submit that no such specific, objective teaching exists in these prior art references. The § 103(a) rejection must therefore fail at least for this lack of any specific, objective teaching to make the combination suggested by the Examiner.

With respect to independent claim 28, Applicants respectfully submit that this claim recites, in relevant part, that the plurality of particles are chosen from “organic hollow particles.” The § 103(a) rejection, however, apparently fails to take into account

this recitation because it is not even alleged by the Examiner that the resin powders of Pollet meet this recitation, and Applicants submit they do not.

Therefore, Pollet taken in combination with Barber and Jia does not teach or suggest the inventions recited in at least independent claims 1, 28, and 32. Hence, Applicants respectfully request the Examiner to withdraw this rejection.

IV. Conclusion

In view of the foregoing remarks, Applicants respectfully request the reconsideration of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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Dated: May 13, 2003

By: 

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